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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,083	03/01/2002	Katsuhide Oshima	220204US0	9118

22850 7590 06/25/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WILKINS III, HARRY D

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/085,083	Applicant(s) OSHIMA ET AL.	
	Examiner Harry Wilkins	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Claims 11-26 remain for examination.
2. The 35 U.S.C. 112, second paragraph rejection applied to claims 11-26 has been withdrawn in view of the amendment filed March 30, 2004.

The obviousness-type double patenting rejection applied to claims 11-26 has been withdrawn in view of the Terminal Disclaimer filed March 30, 2004.

Claim Rejection-35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-12, 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preikschat et al (6,287,704).

Preikschat et al ('704) is applied to the claims for the same reason stated in paragraph 4 of the last Office action.

5. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huvar (4,349,392)

Huvar ('392) is applied to the claims for the same reason stated in the paragraph 5 of the last Office action.

6. Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preikschat et al (6,287,704) or Huvar (4,349,392) in view of The ASM Handbook, vol. 13, 1992, pages 1-3.

Preikschat et al, Huvar et al and ASM Handbook, vol. 13 are applied to the claims for the same reason stated in paragraph 6 of the last Office action.

7. Applicant's arguments filed March 30, 2004 have been fully considered but they are not persuasive. In the remarks, applicants argued that:

(1) The corrosion resistance for the cobalt-containing embodiment of Preikschat et al is significantly worse than for the Examples of the instant invention;

(2) The disclosure in Preikschat et al is considerably broader than the instant invention. For example, the present invention requires cobalt, however, it is optional in Preikschat et al. The present invention requires oxalic acid and Preikschat et al discloses that their chromium(III) complex preferably has chelate ligands selected from a large group of compounds including dicarboxylic acids and oxalic acid. Preikschat et al neither discloses nor suggests that the presence of oxalic acid allows the cobalt concentration in the conversion film to increase by forming a salt with cobalt in the conversion film; and

(3) The structural formula at col. 2, line 1244, which has the formula
HOOC-COOH in Huvar, excludes oxalic acid as claimed.

8. With respect to the arguments (1)-(2) above, it is noted that the applicants have demonstrated that the corrosion resistance of Comparative Example 3, i.e. Preikschat et al, where cobalt compound and malonic acid were used, is significantly worse than Examples of the instant invention. Because Preikschat et al clearly teach that the addition of cobalt into the chromatic coating solution would enhance the corrosion protection (see col. 5, lines 17-18), and Preikschat et al also teach that the chromium(III) complex in the processing solution can be selected from oxalic, malonic, succinic, glutaric, ..., wherein oxalic acid is the first choice, therefore, in order to demonstrate the criticality of the cobalt/oxalic acid as claimed, the applicants have burden to provide comparison results to compare the claimed cobalt/oxalic acid with cobalt/other represented ^{ative}~~ed~~ chelate ligands listed in Preikschat et al in terms of corrosion resistance according to the same processing steps. Therefore, it is the examiner's position that the submitted data in the specification is insufficient to remove the prima-facie obviousness rejection based on Preikschat et al ('704).

9. With respect to the argument (3) above, according to Merriam-Webster's Collegiate Dictionary, page 172 (see the attachment), carboxylic acid is an organic acid containing one or more carboxyl groups (i.e. COOH). Oxalic acid has the formula HOOC-COOH (see "Dictionary of Organic Compounds," page 4965, attached). Therefore, in contrary to the applicants' assertion, oxalic acid is indeed a carboxylic acid. Because Huvar ('392) does teach the use of the

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claimed oxalic acid in the processing solution for forming a hexavalent Cr free, trivalent chromatic conversion film, the 103 rejection based on Huvar ('392) should sustain.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

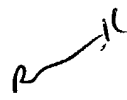
11. Any inquiry concerning this communication should be directed to Harry Wilkins at telephone number (571)272-1251.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571)-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAB


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700